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OFFICE OF PETITIONS

In re Application of : ON PETITIONS
Bosslet et al. : UNDER 37 CFR 1.183
Application No.: 10/728,098 : AND REQUEST FOR
Filed: December 5, 2003 : RECONSIDERATION
Atty. Docket No. DORRIE-0007 : OF PATENT TERM ADJUSTMENT

This is in response to the "PETITION UNDER 37 CFR § 1.183 REQUESTING DELAYED ACCEPTANCE OF THE APPLICATION TO ADJUST FOR PATENT TERM UNDER 37 C.F.R. § 1.705(b) and the "APPLICATION FOR PATENT TERM ADJUSTMENT" both filed March 17, 2009. Applicants petition under § 1.183 for suspension of the requirement under § 1.705(b) that any request for reconsideration of the patent term adjustment indicated in the notice of allowance be filed no later than the payment of the issue fee. Further, applicants request that the patent term in this application be adjusted from one hundred seventy-nine (179) days to five hundred fourteen (514) days.

The petition under 37 CFR 1.183 is dismissed.

The request for reconsideration of patent term adjustment under 37 CFR 1.705(b) is dismissed as untimely filed.

RELEVANT STATUTES AND RULES

37 CFR 1.183 provides that:

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, *sua sponte*, or on petition of the interested party, subject to such other

requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

35 U.S.C. 154(b)(3)(B), provides that:

Under the procedures established under subparagraph (A), the Director shall-

(i) make a determination of the period of any patent term adjustment under this subsection, and shall transmit a notice of that determination with the written notice of allowance of the application under section 151; and

(ii) provide the applicant one opportunity to request reconsideration of any patent term adjustment determination made by the Director.

37 C.F.R. 1.705 provides, in pertinent part, that:

(a) The notice of allowance will include notification of any patent term adjustment under 35 U.S.C. 154(b).

(b) Any request for reconsideration of the patent term adjustment indicated in the notice of allowance, except as provided in paragraph (d) of this section, and any request for reinstatement of all or part of the term reduced pursuant to § 1.704(b) must be by way of an application of patent term adjustment. An application for patent term adjustment must be filed no later than the payment of the issue fee but may not be filed earlier than the date of the mailing of the notice of allowance.

OPINION

Pursuant to 35 U.S.C. 154(b)(3)(B) and implementing regulation 37 C.F.R. 1.705, an applicant shall receive an initial determination of patent term adjustment with the mailing of the Notice of Allowance and shall be given one opportunity to request reconsideration of that determination by way of filing an application for patent term adjustment prior to the payment of the issue fee.

On December 17, 2008, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) that indicated

that the patent term adjustment to date is 179 days. The issue fee payment was received in the Office on March 13, 2009. No filing of an application for patent term adjustment preceded the payment of the issue fee. The period for filing an application for patent term adjustment requesting reconsideration of the initial determination of patent term adjustment at the time of the mailing of the notice of allowance ended upon payment of the issue fee on March 13, 2009.

On March 17, 2009, applicants filed the instant petition stating that:

It is counsel's normal practice to pay issue fees the day before the due date. In this application, however, the applicants had inquired about the possibility for reconsideration of PTA and undersigned's staff, unaware of the possibility that Applicants might decide to file an Application for Patent Term Adjustment, inadvertently paid the issue fee one day early on 16 March 2009.

Excerpt from *Petition under 37 CFR § 1.183 Requesting Delayed Acceptance of the Application to Adjust for Patent Term Under 37 CFR § 1.705(b)*, filed March 17, 2009, p. 1.

Having considered applicants' argument, it is concluded that, in this instance, waiver of the requirement that the application for patent term adjustment be filed prior to the payment of the issue fee is not appropriate. It appears that there was an apparent lack of communication between counsel and counsel's staff and that counsel's staff failed to adhere to counsel's alleged stated practice of paying issue fees the day before the due date for the issue fee. Neither of these errors, while inadvertent, amounts to an 'extraordinary' situation as is meant by 37 CFR 1.183 such that justice requires waiver of the requirements of 37 CFR 1.705(b).

As there is no dispute that this application for PTA was filed after payment of the issue fee and it has been concluded that waiver of the requirement is not warranted, it is appropriate to dismiss this application for patent term adjustment as untimely filed.

In view thereof, the petition under 37 CFR 1.183 for waiver of the two-month requirement of 37 CFR 1.705(b) is dismissed.

The fee for a petition under 37 CFR 1.183 is \$400.00. As the amount of \$130.00 was received on March 17, 2009, towards the satisfaction of the petition fee, deposit account 13-3402 will be charged an additional \$270.00 for the outstanding amount.

Accordingly, consideration now turns to the Application for Patent Term Adjustment.

ON APPLICATION FOR PATENT TERM ADJUSTMENT

This is a decision on the "APPLICATION FOR PATENT TERM ADJUSTMENT," filed March 17, 2009. Therein, applicants request correction of the patent term adjustment (PTA) indicated in the patent to five hundred fourteen (514) days.

37 CFR 1.705(b) provides the sole avenue before the Office for requesting reconsideration of the Office's initial determination of patent term adjustment. Moreover, § 1.705(b) states, in pertinent part, that "[a]n application for patent term adjustment...must be filed no later than the payment of the issue fee but may not be filed earlier than the date of the mailing of the notice of allowance". Since the request was not filed before, or on the same day as the issue fee was paid, the request is properly dismissed as untimely filed.

CONCLUSION

It is determined that waiver of the requirement pursuant to 37 CFR 1.183 is not warranted. Accordingly, the request for reconsideration of the patent term adjustment under 37 CFR 1.705(b) filed after payment of the issue fee is dismissed as untimely filed.

Receipt of the fee for the application for patent term adjustment is acknowledged.

The application file is being forwarded to the Office of Data Management for issuance of the patent. The patent term adjustment indicated on the patent (as shown on the Issue Notification mailed about three weeks prior to patent issuance) will include any additional adjustment accrued both for Office delay in issuing the patent more than four months after payment of the issue fee and satisfaction of all outstanding

requirements, and for the Office taking in excess of three years to issue the patent (to the extent that the three-year period does not overlap with periods already accorded¹).

Telephone inquiries specific to this matter should be directed to Kenya A. McLaughlin, Petitions Attorney, at (571) 272-3222.

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¹ See 35 U.S.C. 154(b)(1)(B), 35 U.S.C. 154(b)(2)(A), and 37 CFR ' 1.703(f). See also Revision of Patent Term Extension and Patent Term Adjustment Provisions; Final Rule, 69 Fed. Reg. 21704 (April 22, 2004).